



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/090,803	03/06/2002	William C. Houghton	06975-164001	6900

26171 7590 09/13/2006

FISH & RICHARDSON P.C.
P.O. BOX 1022
MINNEAPOLIS, MN 55440-1022

EXAMINER

O'STEEN, DAVID R

ART UNIT	PAPER NUMBER
----------	--------------

2623

DATE MAILED: 09/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/090,803	HOUGHTON, WILLIAM C.	
	Examiner	Art Unit	
	David R. O'Steen	2623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 March 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 March 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|----------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>6-6-2002</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Note to Applicant

1. Art Units 2611, 2614 and 2617 have changed to 2623. Please make all future correspondence indicate the new designation 2623.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 38 and 39 are drawn to functional descriptive material that makes reference to a computer program, said program stored on a computer readable medium. On page 3, lines 21-22 of the specification, the applicant indicates that a computer readable medium may be propagated signal among other things. A signal is not statutory subject matter. Therefore, the specification defines the computer readable medium to be a signal. A "signal" embodying functional descriptive material is neither a process ("actions"), machine, manufacture, nor composition (tangible thing) and therefore does not fall into the four statutory categories of U.S.C 101. Rather "signal" is a form of energy, in the absence of any physical structure or tangible material. Because the full scope of the claim as properly read in light of the disclosure encompasses non-statutory subject matter, the claim as a whole is non-statutory. The examiner suggests amending the claim to include the disclosed tangible computer readable medium, while at the same time excluding the intangible medium such as signals, carrier wave, etc.

defined in the specification. Any amendment to the claims should be commensurate with its corresponding disclosure.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 11, and 35-39 are rejected under 35 U.S.C. 102(b) as being anticipated by Kurland (US 4,603,232).

As regards Claims 1, 36, and 38, Kurland discloses a method, apparatus, and computer readable medium for polling interactive television viewers, the method comprising: preparing a set of polling requests (cols. 7 and 8, lines 61-68 and 1-11) that each ask an interactive television to select an element from a group of two or more elements (such as questionnaire similar to that of fig. 3, col. 9, lines 43-57, note that the graphical user interface provides a variety of ways for eliciting user responses- through keyboard typing, using a character-reading wand, yes-no questions, col. 5, lines 25-39); connecting to one or more interactive television viewers (col. 10, lines 14-17); sending the set of polling requests to the one or more set top systems of the one or more interactive viewers (the device comprising figs. 31.34, 31.108, and 31.106 functions as a set top box with up stream connectivity through modem, 31.26, fig. 31.14a, cols. 9 and 10, lines 58-68 and 1-24); receiving responses to the set of polling requests from

one or more interactive television viewers (col. 7, lines 49-51); evaluating the responses to the set of polling requests (col. 7, lines 49-52); and preparing a new polling request including two or more elements selected based on the evaluation of the responses to the set of polling requests (fig. 3 shows that a questionnaire generally has more than one question, col. 7, lines 49-57).

As regards Claim 35, 37, and 39, Kurland discloses a method, apparatus, and computer program stored on a computer readable medium for participating in an interactive television poll, the method comprising: connecting to a host (col. 8, lines 17-43); receiving a set of polling requests (col. 8, lines 17-43); completing the polling requests (col. 9, lines 1-9); transmitting the responses to the polling requests (col. 7, lines 49-51); and receiving a new polling request including two or more elements selected based on the responses of one or more interactive television viewers to the set of polling requests (fig. 3 shows that a questionnaire generally has more than one question, col. 7, lines 49-57).

As regards Claim 11, Kurland further discloses designating polling rules for targeting the interactive television viewers (such as demographic data, col. 7, lines 57-60).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2, 12-15, 17-18, 21-23, 25-26, and 30 are rejected under 35 U.S.C.

103(a) as being unpatentable over Kurland (US 4,603,232) in view of Shah-Nazaroff (US 2002/0053077).

As regards Claim 2, Kurland discloses the method of claim 1 but fails to disclose that the two polling requests have two different sets of elements. Shah-Nazaroff discloses that the two polling requests have two different sets of elements (fig. 4, questions and answers to “Do you approve of the President’s Performance in the Office” and “Your approval of the President’s performance in Office has” are different).

At the time of the invention, it would have been obvious for one skilled in the art to combine the survey format of Shah-Nazaroff, an analogous art, with the questionnaire method of Kurland to give the user a variety of questions to respond to with a variety of answers.

As regards Claim 12, Kurland discloses the method of Claim 11 but fails to disclose determining context information of interactive television viewers. Shah-Nazaroff discloses determining context information of interactive television viewers (such as what program they are watching or just watched, paragraph 25).

At the time of the invention, it would have been obvious for one skilled in the art to combine the context information of Shah-Nazaroff, an analogous art, to the survey method of Kurland to ask more specific questions, perhaps questions relating to the program just watched.

As regards Claim 13, Kurland discloses applying the targeting rules to the context information to identify targeted interactive television viewers (such as by demographic data, col. 7, lines 57-60).

As regards Claim 14, Shah-Nazaroff discloses that determining the context information includes determining television programming being viewed by an interactive television viewer at a particular time (such as what program they are watching or just watched, paragraph 25).

As regards Claim 15, Shah-Nazaroff discloses determining television programming being viewed comprises determining the television programming tuned by a set top box (paragraphs 42, 43, and paragraph 53, lines 11-18).

As regards Claim 17, Shah-Nazaroff discloses determining context information associated with television programming available for delivery to the interactive television viewer (such as the program just watched, fig. 4, paragraph 42).

As regards Claim 18, Shah-Nazaroff discloses that determining context information based upon a television signal received by a set top box (such as the program just watched, fig. 4, paragraphs 42 and 43).

As regards Claim 21, Shah-Nazaroff discloses that preparing a set of polling requests includes preparing the polling requests based on context information associated with the television programming (such as preparing the survey to pertain to a program just watched, paragraph 44, and figs. 4 and 6).

At the time of the invention, it would have been obvious for one skilled in the art to combine the tailoring of polling requests as done in Shah-Nazaroff with the survey

method of Kurland so that the survey is most effective a gathering the opinions of the viewers.

As regards Claim 22, Shah-Nazaroff further discloses comprises determining context information based upon a television series (Shah-Nazoff deals with providing surveys about programming such as in fig. 4, paragraph 44, an this programming can take on a variety of forms such as television series which oftentimes are sitcoms, paragraph 22).

At the time of the invention, it would have been obvious for one skilled in the art to combine the tailoring of polling requests as done in Shah-Nazaroff with the survey method of Kurland so that the survey is most effective a gathering the opinions of the viewers.

As regards Claim 23, Shah-Nazaroff further discloses comprises determining context information based upon a television series (Shah-Nazoff deals with providing surveys about programming such as in fig. 4, paragraph 44, an this programming can take on a variety of forms such an episode of a television show which oftentimes are sitcoms or a news segment, paragraph 22).

At the time of the invention, it would have been obvious for one skilled in the art to combine the tailoring of polling requests as done in Shah-Nazaroff with the survey method of Kurland so that the survey is most effective a gathering the opinions of the viewers.

As regards Claim 25, Shah-Nazaroff discloses determining context information based on a program content category (such as asking specific questions about news broadcast, fig. 4, or children's film, fig. 6).

At the time of the invention, it would have been obvious for one skilled in the art to combine the tailoring of polling requests as done in Shah-Nazaroff with the survey method of Kurland so that the survey is most effective at gathering the opinions of the viewers.

As regards Claim 26, Shah-Nazaroff discloses prompting the interactive television viewer to select one element in the polling request of two or more elements (such as asking if approval increased or decreased or stayed the same, fig. 4).

At the time of the invention, it would have been obvious for one skilled in the art to combine the tailoring of polling requests as done in Shah-Nazaroff with the survey method of Kurland so that the survey will be intuitive and easy to fill out by the user.

As regards Claim 30, Shah-Nazaroff discloses that evaluating the responses includes determining which element in the polling request received the most votes (fig. 5).

Claims 3-5, 7, 10, and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kurland (US 4,603,232) in view of Lett (US 5,539,822).

As regards Claim 2, Kurland discloses the method of claim 1 but fails to disclose that each element appearing in the set of polling requests is different from the every element appearing in the set of polling requests. Lett discloses that each element

Art Unit: 2623

appearing in the set of polling requests is different from the every element appearing in the set of polling requests (fig. 3H).

At the time of the invention, it would have been obvious for one skilled in the art to combine the survey format of Lett, an analogous art, with the questionnaire method of Kurland to give the user a variety of answers to use when responding to questions.

As regards Claim 4, Lett discloses that evaluating the responses includes tallying the responses that have been received after a time limit (col. 16, lines 43-67).

At the time of the invention, it would have been obvious for one skilled in the art to combine the “timeout” of Lett, an analogous art, with the questionnaire method of Kurland to insure the prompt collection of data.

As regards Claim 5, Lett further discloses that the time limit is applied relative to a period that begins when the polling request is initially displayed to an interactive television viewer (col. 16, lines 43-48).

As regards Claim 7, Lett discloses displaying particular content to the interactive television viewers based on evaluating the responses (such as showing the results gleaned from a plurality of participants to the questionnaire, fig. 4B.350 and col. 16, lines 64-67).

At the time of invention, it would have been obvious for one skilled in the art to combine the summarization data to viewers, as done in Lett, an analogous art, to the survey method of Kurland because viewers are often curious about other people's opinions.

As regards Claim 10, Lett discloses that the displaying of particular content uses the set top system (fig. 1.14, col. 5, lines 6-19 and 34-41).

At the time of invention, it would have been obvious for one skilled in the art to use the set top system to display results, as done in Lett, an analogous art, to the survey method of Kurland so that the results are easily accessible to the viewer.

As regards Claim 34, Lett discloses that the set of polling requests includes sending a display to overlay television programming (col. 16, lines 33-36).

At the time of invention, it would have been obvious for one skilled in the art to use an overlay to display the survey, as done in Lett, an analogous art, to the survey method of Kurland so that the survey is easily accessible to the viewer.

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kurland (US 4,603,232) in view of Lett (US 5,539,822) and in further view of Hattori (US 5,719,619).

As regards Claim 6, As regards Claim 2, Kurland and Lett disclose the method of claim 4 but fail to disclose that the time limit is common to all of the interactive television viewers. Hattori discloses that the time limit is common to all of the interactive television viewers (such as five minutes, col. 27, 48-60).

At the time of the invention, it would have been obvious for one skilled in the art to combine the time period of Hattori, an analogous art, with the questionnaire method of Kurland and Lett to insure the prompt collection of valid data.

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kurland (US 4,603,232) in view of Lett (US 5,539,822) and in further view of Shah-Nazaroff (US 2002/0053077).

As regards Claim 8, Kurland and Lett disclose the method of Claim 7 but fails to disclose that the particular content includes a graphical user interface. Shah-Nazaroff discloses that the particular content includes a graphical user interface (such as an EPG, fig. 3, paragraphs 33-37).

At the time of the invention it would have been obvious to one skilled in the art to put the modified EPG of Shah-Nazaroff alongside the survey results of Kurland and Lett to allow the user easy access to highly rated programs on the survey.

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kurland (US 4,603,232) in view of Lett (US 5,539,822) and in further view of Bejan (US 5,465,384).

As regards Claim 9, Kurland and Lett disclose the method of Claim 7 but fails to disclose that the particular content includes multimedia data. Bejan discloses that the particular content includes multimedia data (such video scenes, abstract, figs. 2.114 and 2.116, col. 8, lines 7-39).

At the time of the invention it would have been obvious to one skilled in the art to show the user selected scenes of Bejan after the survey of Kurland and Lett to allow the user some control over programming content.

Claims 16, 19, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kurland (US 4,603,232) in view of Shah-Nazaroff (US 2002/0053077) and in further view of Belmont (US 5,819,156).

As regards Claim 16, Kurland and Shah-Nazaroff disclose the method of Claim 14 but fail to disclose that determining television programming being viewed comprises determining the television programming using an EPG. Belmont discloses that determining television programming being viewed comprises determining the television programming using an EPG (col. 3, lines 53-65).

At the time of the invention, it would have been obvious to one skilled in the art to combine the television programming identification system of Belmont, an analogous art, with the survey system of Kurland and Shah-Nazaroff to make sure that the questionnaire is appropriate for the program just watched.

As regards Claim 19, Kurland and Shah-Nazaroff disclose the method of Claim 17 but fail to disclose determining context information based upon a channel identification number. Belmont discloses determining context information based upon a channel identification number (by tracking channels watched and cross-referencing them with a program guide, col. 3, lines 53-65).

At the time of the invention, it would have been obvious to one skilled in the art to combine the channel identification system of Belmont, an analogous art, with the survey system of Kurland and Shah-Nazaroff to make sure that the questionnaire is appropriate for the program just watched.

As regards Claim 24, Kurland and Shah-Nazaroff disclose the method of Claim 17 but fail to disclose determining context information based upon an EPG identity. Belmont discloses determining context information based upon an EPG identity (by tracking channels watched and cross-referencing them with a program guide, questions could then be tailored, col. 3, lines 53-65).

At the time of the invention, it would have been obvious to one skilled in the art to combine the program identification based on EPG data of Belmont, an analogous art, with the survey system of Kurland and Shah-Nazaroff to make sure that the questionnaire is appropriate for the program just watched by the viewer.

Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kurland (US 4,603,232) in view of Shah-Nazaroff (US 2002/0053077) and in further view of Aras (US 5,872,588).

As regards Claim 20, Kurland and Shah-Nazaroff disclose the method of Claim 17 but fail to disclose determining context information based upon a broadcast identifier. Aras discloses determining context information based upon a channel identification number (by embedding the broadcaster ID inside the tag, it becomes easy to identify the broadcaster, col. 8, lines 52-65).

At the time of the invention, it would have been obvious to one skilled in the art to combine the broadcaster identification system of Aras, an analogous art, with the survey system of Kurland and Shah-Nazaroff to make sure that the questionnaire is appropriate for the program just watched.

Claim 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kurland (US 4,603,232) in view of Frost (US 5,041,972).

As regards Claim 27, Kurland discloses the method of Claim 1 but fail to disclose prompting an interactive television viewer to rank order a list of elements. Frost discloses prompting an interactive television viewer to rank order a list of elements (fig. 1 and col. 7, lines 32-54).

At the time of the invention, it would have been obvious to one skilled in the art to combine the ranking interface of Frost, an analogous art, with the survey system of Kurland to give the user an easy way to evaluate programs.

Claims 28-29 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kurland (US 4,603,232) in view of Shah-Nazaroff (US 2002/0053077) and in view of Inaba (US 5,880,789).

As regards Claim 28, Kurland discloses the method of Claim 1 but fails to disclose determining two or more elements in the new polling request includes a most selected element in a first polling request and a most selected element in a second polling request. Shah-Nazaroff discloses determining the most selected element in a first polling request and a most selected element in the second polling request (fig. 5).

At the time of the invention, it would have been obvious to one skilled in the art to combine the results tabulation of Shah-Nazaroff, an analogous art, with the survey system of Kurland to keep track of the most popular user choices.

Kurland and Nazaroff, however, fail to disclose that most selected elements comprise two or more elements in a new polling request. Inaba discloses that most selected elements comprise two or more elements in a new polling request (Inaba discloses a tournament system for user game, which involves picking the user with the most points to proceed, col. 5, lines 53-54).

At the time of the invention it would have been obvious to one skilled in the art to combine the element selection system of Inaba, an analogous art, with the poll creation method of Kurland and Shah-Nazaroff to allow users to pick programs using a common, easy-to-understand tournament system.

As regards Claim 29, Inaba further discloses that the set of polling requests continues until there is one element that has not been selected to a lesser degree than other elements in any polling request of the most selected elements and the other elements (a tournament normally proceeds until there is a clear winner, col. 5, lines 53-54).

As regards Claim 31, the rejection is similar to the rejection of Claim 28. Shah-Nazaroff discloses that determining two or more elements in the new polling request includes a least selected element in a first polling request and a least selected element in a second polling request (Shah-Nazaroff shows which element receives the least votes as well, fig. 5, and this could be used as the criterion for advancing in the tournament).

Claims 32-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kurland (US 4,603,232) in view of McKissick (US 2006/0190966).

As regards Claim 32, Kurland discloses the method of Claim 1 but fail to disclose sending a set of polling requests includes sending an instant message. McKissick discloses sending a set of polling requests includes sending an instant message (McKissick makes it clear any message with any content can be sent to a set top box in a timely fashion using an instant message, paragraph 88).

At the time of the invention, it would have been obvious to one skilled in the art to combine the instant messaging of McKissick, an analogous art, with the survey system of Kurland to provide a widely known and reliable way to send the survey to the user.

As regards Claim 33, McKissick discloses sending the set of polling requests includes sending an electronic mail message (McKissick makes it clear any message with any content can be sent to a set top box in a timely fashion using an e-mail, paragraph 121).

At the time of the invention, it would have been obvious to one skilled in the art to combine the e-mail feature of McKissick, an analogous art, with the survey system of Kurland to provide a widely known and reliable way to send the survey to the user.

Conclusion

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to David R. O'Steen whose telephone number is 571-272-7931. The examiner can normally be reached on 8:30 to 5.

Art Unit: 2623

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Grant can be reached on 571-272-7294. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

DRO


HAITRAN
PRIMARY EXAMINER